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EXAMINER

ALLEN, WILLIAM J

ART UNIT

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3625

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/764,523

Applicant(s)

NAKASHIMA, KENJI

Examiner

William J. Allen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 7/9/2007 have been fully considered but they are not persuasive.

On page 9 of Applicant's remarks, Applicant asserts that Niki does not disclose "setting the user as an object user for the group and purchasing processing corresponding to the user identification information" and further asserts that Niki does not state that a representative customer "object user" creates a group. To the contrary, as explicitly taught by Niki, the leader of the group is defined to be the person making the request for the bulk purchase (see 0037) and further where the management server gives the leader a group/customer ID for identifying the group and the purchasers (see 0042). The leader is then in charge of informing each group member of the customer ID (see 0043). The Examiner hereby asserts that because the leader of the group makes a request for the bulk purchase and is thereby endowed the power over the distribution of customer IDs for that particular group, the leader is effectively set as an object user.

In addition, Applicant also asserts that Niki does not teach "transmitting, upon the apparatus receiving an access from a user terminal of the users with user identification information which coincides with the user identification information stored in the identification information storage unit, a message to urge the users to carry out the group purchasing". In this regard, it is important to note that it is the combination of Niki and Morrisroe that teach this feature, as cited in the previous office action, and not merely by Niki as asserted by the Applicant on page 10 of the remarks. Niki further teaches where each additional member of the

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group purchase is informed of an ID to access the group purchasing system, thereby “urging” the users to complete a purchase via the group purchasing system using the ID in order to obtain a discount (see at least: abstract, 0041-0045, 0056-0057, Fig. 9). Despite this teaching, Niki lacks a teach of upon the apparatus receiving an access from a user terminal of the users with user identification information which coincides with the user identification information stored in the identification information storage unit, transmitting the message to urge. Morrisroe then teaches where a user logs in using a username and password associated with the user’s profile (i.e. *user identification coinciding with stored user identification information*). Using that information, the presented advertisements can include differing versions based on the information extracted about the user, thereby providing an add tailored to be effective to the user (see at least: 0036-0037). Furthermore, these adds may be tailored to various scenarios, such as calendar reminders (0039), product upgrades (0040), and, most importantly, to alert users of impending expirations such as bidding in an online auction (0041). In any case, displaying tailored advertisements such as these including the time elapsed are used to generate a sense of urgency, thereby encouraging purchase or appropriate action by the user before the expiration upon user access of the system(see at least: 0021). It is then clear that the combination of Niki and Morrisroe teach the cited claim elements.

Additionally, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Regarding claim 2, the Examiner asserts that the citations provided clearly show the teaching of “wherein the product purchasing execution unit executes, upon receiving a group purchasing procedure request for a different kind of product based on the group purchasing with the user identification information from the user terminal, the product purchasing procedure for a user who made the group purchasing procedure request”. It is thereby noted that the product purchasing procedure is done for any user.

Regarding claim 6, the Examiner notes paragraph 107 of Niki which states “When it is within the purchase period, the bulk purchase group management server 1 calculates a discount rate (step S14), and requests the payment agency 4 to refund the calculated discount (step S15)”. Thereby, for each purchaser purchasing during the purchasing period, a discount is calculated. The Examiner also points the previous citations provided in previous action.

Regarding the rejection under 35 USC 101, the Examiner notes that the inclusion of “a computer comprising” the various units recited overcomes the rejection set forth in the previous action. Of important note is the computer’s implied storage and execution of the various units.

Regarding the restriction through original presentation of claim 24, the Examiner notes that, despite the arguments of Applicant, claim 24 is of a different scope than the originally presented invention. Thereby, claim 24 remains withdrawn.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 9, 12-18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki et al. (US 20020037257) in view of Morrisroe (US 20030229542).**

**Regarding claim 1, Niki teaches:**

*an identification information issuing unit that issues, upon receiving a group purchasing application request for a product from a user terminal, user identification information corresponding to the group purchasing application request (see at least: Fig. 1, abstract, 0042, 0056, 0070, 0144); and*

*a product purchasing execution unit that executes, upon receiving a purchasing procedure request for a product from the user terminal with the user identification information issued, a product purchasing procedure for a user who made the purchasing procedure request (see at least: Fig. 1 and 5, 0041-0049, 0053-0060),*

*and sets the user as an object user for the group purchasing processing corresponding to the user identification information (see at least: 0030, 0037, 0041-0042, 0135, Fig. 10);*

*an identification information storing unit that stores, upon the identification information issuing unit receiving a group purchasing application request for a product including at least a plural pieces of user identification information to identify a plurality of users, respectively, the*

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*user identification information of the users* (see at least: 0038, 0042-0044, 0066, 0070, 0072, 0079, 0099, 0105, 0133, 0056, 0072, Fig. 1(II-III), 7(s4), and 9).

Niki teaches all of the above as noted and further teaches where a leader of a bulk purchasing group accesses the group purchasing system and creates a group purchasing request via a terminal. Subsequently, each additional member of the group purchase is informed of an ID to access the group purchasing system, thereby “urging” the users to complete a purchase via the group purchasing system using the ID in order to obtain a discount (see at least: abstract, 0041-0045, 0056-0057, Fig. 9). Furthermore, in response to the transmitted message informing the additional member of the ID, a customer performs a purchase operation and is set as an object user for the group purchasing process (see at least: 0135, Fig. 10). Niki, despite these teachings, does not teach where the leader accesses the system *with user identification information which coincides with the user identification information stored in the identification information storing unit*.

In the same field of endeavor, Morrisroe teaches a system for electronic marketing and sales advertising that presents dynamic “advertisements” to users (see at least: abstract, 0008-0010). More specifically, Morrisroe teaches where a user logs in using a username and password associated with the user’s profile (i.e. *user identification coinciding with stored user identification information*). Using that information, the presented advertisements can include differing versions based on the information extracted about the user, thereby providing an add tailored to be effective to the user (see at least: 0036-0037). Furthermore, these adds may be

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tailored to various scenarios, such as calendar reminders (0039), product upgrades (0040), and, most importantly, to alert users of impending expirations such as bidding in an online auction (0041). In any case, displaying tailored advertisements such as these including the time elapsed are used to generate a sense of urgency, thereby encouraging purchase or appropriate action by the user before the expiration (see at least: 0021).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki to have included *with user identification information which coincides with the user identification information stored in the identification information storing unit* as taught by Morrisroe in order to provide a system that presents tailored adds to create a sense of urgency, thereby encouraging purchase or appropriate action by the user before the expiration (see at least: Morrisroe, 0021).



**Regarding claims 2-6, 9, 12-18, and 20-23, Niki in view of Morrisroe teaches:**

**(2)** *wherein the product purchasing execution unit executes, upon receiving a group purchasing procedure request for a different kind of product based on the group purchasing with the user identification information from the user terminal, the product purchasing procedure for a user who made the group purchasing procedure request (see at least: Niki , 0068, 0138-0140, Fig. 11).*

**(3)** *an identification information transmitting unit that transmits the user identification information issued from the identification information issuing unit to the user terminal, wherein the product purchasing procedure execution processor receives the product purchasing procedure request with the user identification information transmitted (see at least: Niki , Fig. 1 and 3, abstract, 0042, 0056, 0070).*

**(4)** *wherein the identification information issuing unit receives a group purchasing application request indicating a group purchasing of a product for a predetermined number of persons from the user terminal (see at least: Niki , 0004, 0042-0043). The Examiner notes that the purchaser side specifies the members of the bulk purchase group when requesting a bulk purchase of products. The specification of members done so as part of the request constitutes a pre-determined number of participants.*

**(5)** *a shipping processing request unit that makes a processing request for shipping a product to a user who uses the user terminal when the product purchasing execution unit executed the product purchasing procedure (see at least: Niki , 0040, 0058).*

**(6)** *a discount amount calculating unit that calculates, after the product purchasing execution unit completes execution of the product purchasing procedure for each user, a*

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*discount amount for a product to be paid back to the user corresponding to number of the object users for the group purchasing processing; and a discount amount output unit that outputs the discount amount calculated (see at least: Niki , 0110-0115, 0123-0128, Fig. 6 and 8).*

*(9) wherein the identification information issuing unit issues a uniform resource locator of last page of either of the processing of the group purchasing application request and the purchasing procedure request (see at least: Niki , 0034, 0066-0068, Fig. 11-13). The Examiner notes that a homepage provides access to the contents concerning a bulk purchase group, with each individual bulk purchasing page on the WWW server representing an individual page for that group purchase. Each individual web page has an assigned URL.*

*(12) an expiration date creating unit that creates an expiration date of the user identification information issued by the identification information issuing unit (see at least: Niki , 0014, 0050, 0061, 0096, 0107, 0127-0128);*

*wherein the product purchasing execution unit sets, upon receiving the product purchasing procedure request with the user identification information, a user who made the purchasing procedure request as the object user for the group purchasing processing corresponding to the user identification information, if the expiration date of the user identification information is valid (see at least: Niki , 0107-0108, 0135, Fig. 5, Fig. 10).*

*(13) a user information management unit that manages information on each user included in the product purchasing procedure request by associating the information with the group who made the group purchasing application (see at least: 0042-0043, 0056, 0070).*

*(21) wherein the message transmitting unit transmits a message directly to the user terminals of the users, upon the apparatus receiving an access from a first user terminal of the*

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*users with user identification information which coincides with the user identification information stored in the identification information storing unit, to urge the users to carry out the group purchasing* (see at least: Niki, abstract, 0041-0045, 0056-0057, 0070, 0076, 0159, Fig. 9; Morrisroe, abstract, 0036-0037, 0039-0041).

**Regarding claims 14-18, 20, and 22-23,** these closely parallel claims 1-6, 9, 12-13, and 21. Claims 14-18, 20, and 22-23 are thereby rejected under the same rationale for at least the reasons above.

**3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki in view of Morrisroe, as applied above, and further in view of Tiley et al. (US 20010032443.**

**Regarding claim 7,** Niki in view of Morrisroe teaches all of the above and teaches calculating discounts/refund amounts for a bulk purchase group (see at least: 0110-0115, 0123-0128, Fig. 6 and 8). Niki in view of Morrisroe, however, does not expressly teach wherein the discount is calculated as *a credit point*. Tiley teaches calculating various discounts and in store credits (i.e. *credit points*) to provide incentives to shoppers (see at least: 0043, 0049, 0136-0138). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included discount amounts in the form of *credit points* as taught by Tiley in order to provide store owners/retailers a system that motivates purchasers to visit their stores (see at least: Tiley, 0049).

**Regarding claim 8,** Niki in view of Morrisroe teaches all of the above and teaches calculating discounts/refund amounts for a bulk purchase group (see at least: 0110-0115, 0123-0128, Fig. 6 and 8). Niki in view of Morrisroe, however, does not expressly teach where the discount amount is calculated *based on a destination area for shipping each product*. Tiley teaches providing incentives for retrieving purchases at specific locations. Purchasers and retailers are permitted to have a package delivered to a specific remote location (i.e. *destination area*) for package pick (see at least: 0058, 0074, 0147-0148). Each remote location/destination provides information about the types of incentives they will provide, with the administrator calculating relevant incentives, such as discounted/reduced shipping costs, according to weighing

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factors provided by the retailers (see at least: 0048, 0107). The uniquely calculated incentives are then provided for view and selection to the purchaser (see at least: 0063, Fig. 1). The Examiner notes that because each remote location, and thereby destination area for a product to be delivered and picked up, has uniquely calculated incentives, Tiley teaches where the discount amount is calculated *based on a destination area for shipping*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included discount amounts in the form of *credit points* as taught by Tiley in order to provide store owners/retailers a system that motivates purchasers to visit their stores (see at least: Tiley, 0049).

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4. **Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki in view of Morrisroe, as applied above, and further in view of Yoshimine et al. (US 20020138827).**

**Regarding claims 10 and 19,** Niki in view of Morrisroe teaches all of the above as noted and further teaches *creating a website exclusive for a group carrying out the product purchasing procedure* (see at least: 0023, 0042-0044, 0145, Fig. 12 and 13). Each individual bulk purchasing site on the WWW server represents an individual site for that specific group purchase request. Though the contents of the homepage are open to the public, group purchase members/purchasers are identified in the registration of the group purchasing request and use an ID that enables the group members/purchasers to place an order. Niki in view of Morrisroe, however, does not teach *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information*. Yoshimine teaches *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information* by determining an appropriate URL corresponding to a user ID (see at least: 0112-0114, 0117, 0122). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information* as taught by Yoshimine in order to provide users with an unmistakable identifying URL through use of familiar indicia such as a most highly desired user ID (see at least: Yoshimine, 0072, 0112).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen  
Patent Examiner  
August 17, 2007



Mark Fadok

Primary Examiner